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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Fish and Richardson P C
Suite 5000 1717 Main Street
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EXAMINER

MORGAN, ROBERT W

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/409,242	Applicant(s) VAID, RAHUL R.	
	Examiner Robert W. Morgan	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. In the amendment filed 3/1/05, the following has occurred: Claims 1-16 have been amended and claims 34-75 are canceled. Now claims 1-16 are presented for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-16 only recite an abstract idea. The recited pre-paid airline ticket system comprising: a processor supporting a pre-paid airline ticketing system; and a storage device in communication with said processor and configured to store... does not apply,

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involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention comprises a storage device in communication with a processor configured to store a record. However, it is not clear whether the storage device communicating with the processor is actively storing a record representative of a pre-paid ticket.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-16 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "...pre-paid airline ticket system comprising: a processor supporting a pre-paid airline ticketing system; and a storage device in communication with said processor and configured to store..." is unclear as to whether the storage device communicating with the processor is actively storing a record representative of a pre-paid ticket but for examination purposes the Examiner has treated the "storage device in communication with said processor and configured to store" as a storage device processing a stored record representative of pre-paid airline ticket.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11, 14-16, 34-38, 41 and 44-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,897,620 to Walker et al. in view of "Hawaiian Air to Offer Tickets Through ATMs" by Wall Street Journal, for substantially the same reasons given in the previous Office Action (dated 12/1/04). Further reasons appear below.

As per claim 1, Walker et al. teaches a pre-paid airline ticket system comprising:

--the claimed processor supporting a pre-paid airline ticketing system (see: column 22, lines 32-33); and

--the claimed storage device in communication with said processor and configured to store a record representing a pre-paid, fixed-price option purchased by a customer to be exercised by the customer to book a flight from among a plurality of flights offered by one of multiple participating air travel carrier is met by the CPU (305, Fig. 3) coupled to a storage device (325, Fig. 3) to process flight information received from the airlines (see: column 7, lines 51 to column 8, lines 6). The Examiner considers the received flight information to be from multiple participating air travel carrier, the record including:

(i) --the claimed plurality of geographic flight parameters and a plurality of non-geographic flight parameters, at least one of the geographic flight parameters being unspecified and at least one of the non-geographic flight parameters being participating is met by the

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unspecified-time ticket that includes receiving identification of flight information such as destination location and departure times, special fares and also receiving information regarding booking a ticket at the special fares (see: column 3, lines 1-11).

Walker et al. fails to teach:

(ii) –the claimed identifier associated with and uniquely identifying the record for the customer to use to exercise the pre-paid, fixed price option to book one of the flights.

Wall Street Journal teaches that Hawaiian Air plans to allow customer and non-customer of Bank of Hawaii to buy flight coupons through the bank's ATMs 24 hours a day using a card issued by the bank or a major credit card (see: paragraph 4). Furthermore, the coupon or "open ticket" will be valid for a year and will cost the same as those purchase from the airline or travel agency. The customer will need to contact Hawaiian Air to reserve space on their desired flight (see: paragraph 4). Since Hawaiian Air is issuing "open tickets" which are valid for year the skilled artisan expects an "open ticket" to include an identifier uniquely identifying the pre-paid airline ticket and operable to be utilized by the customer to book a flight.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Hawaiian Air's "open tickets" as taught by the Wall Street Journal within the unspecified-time airline ticket as taught by Walker et al. with the motivation of providing the customer with a method to purchasing advanced open tickets to allow utmost flexibility thereby better accommodating the traveler.

The amendment to claims 2-16, appears to have been made to merely change "ticket" to "ticketing system", but otherwise do not affect the scope and breadth of the claim as originally

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presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features of claims 2-16 are rejected for the same reasons given in the prior Office Action (dated 12/1/04), and incorporated herein.

Response to Arguments

7. Applicant's arguments filed 12/1/04 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 12/1/04.

(A) In the remarks, Applicants argue in substance that, (1) Examiner has failed to establish a *prima facie* case of obviousness, three basic criteria must be met; (2) Incorporating the Hawaiian Air open ticket into the system of Walker renders the system of Walker unworkable as a ticketing mechanism; and (3) There is no motivation to combine the assigned ticket of Walker into the open ticketing system disclosed by Hawaiian Air since that would render the open ticketing system inoperable; and (4) Hawaiian Air reference teaches away from Applicant's invention as now amended, in particular "record representing a pre-paid, fixed-price option purchased by a customer to be exercised by the customer to book a flight from among a plurality of flights offered by one of multiple participating air travel carrier".

(B) In response to Applicants argument that, (1) Examiner has failed to establish a *prima facie* case of obviousness, three basic criteria must be met; and (3) There is no motivation to combine the assigned ticket of Walker into the open ticketing system disclosed by Hawaiian Air since that would render the open ticketing system inoperable. The Examiner respectfully submits that establishing a *prima facie* case of obviousness is determined on the basis of the evidence as

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a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (paper dated 12/1/04).

In addition, the Examiner recognizes obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lulu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Additionally, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within

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the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the prior Office Action (paper dated 6/3/03), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore, the motivation to combined the teachings of the Wall Street Journal within Walker et al. reference as given in section 5 of the above Office Action is suggested from a passage in the Wall Street Journal paragraph 2, "airline passengers bent on convenience, here is something at least as user-friendly as electronic ticketing: buying plane tickets at an automated teller machine".

(C) In response to Applicants argument that, (2) Incorporating the Hawaiian Air open ticket into the system of Walker renders the system of Walker unworkable as a ticketing mechanism and (3) There is no motivation to combine the assigned ticket of Walker into the open ticketing system disclosed by Hawaiian Air since that would render the open ticketing system inoperable. The Examiner respectfully submits Walker et al. teaches a unspecified-time ticket that includes receiving identification of flight information such as destination location and departure location, special fares and also receiving information regarding booking a ticket at the special fares (see: column 3, lines 1-11). Hawaiian Air teaches a plan to allow customer and non-customer of Bank of Hawaii to buy flight coupons through the bank's ATMs 24 hours a day using a card issued by the bank or a major credit card (see: paragraph 4). In addition, the coupon

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or “open ticket” will be valid for a year and will cost the same as those purchase from the airline or travel agency. The customer will need to contact Hawaiian Air to reserve space on their desired flight (see: paragraph 4). It is respectfully submitted that a passenger’s “desired flight” would include a passenger’s intended destinations or destination range. As such, the proper combination of Walker and Hawaiian Air is to extend Walker’s unspecified-time ticket for a time range to unspecified destination and time ticket for a time range and a range of possible destination, as taught by Hawaiian Air. As such, the Examiner disputes that incorporating the Hawaiian Air open ticket into the system of Walker renders the system of Walker unworkable as a ticketing mechanism.

In addition, the Examiner recognizes obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

(D) In response to Applicants argument that, (4) Hawaiian Air reference teaches away from Applicant’s invention as now amended, in particular “record representing a pre-paid, fixed-price option purchased by a customer to be exercised by the customer to book a flight from among a plurality of flights offered by one of multiple participating air travel carrier”. The Examiner respectfully submits Walker reference is relied on for the teachings a CPU (305, Fig.

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3) coupled to a storage device (325, Fig. 3) to process flight information received from the airlines (see: column 7, lines 51 to column 8, lines 6). The Examiner considers the received flight information to be from multiple participating air travel carrier. Hawaiian Air is relied on for allowing customer and non-customer of Bank of Hawaii to buy flight coupons through the bank's ATMs 24 hours a day using a card issued by the bank or a major credit card (see: paragraph 4). Furthermore, it is respectfully submitted that if Applicant's were correct in his assertion which Examiner does not admit, it has been held that prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is (571) 272-6773. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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rwm



ALEXANDER KALINOWSKI
PRIMARY EXAMINER